

REMARKS

This responds to the Office Action mailed on October 5, 2004.

By way of this amendment, claims 5, 36, and 40-45 have been canceled. Claims 4, 33, 35, and 38 have been amended. No claims have been added. As a result, claims 4, 6, 33-35, and 37-39 are now pending in this application.

Resubmitting Information Disclosure Statement Previously Submitted on July 2, 2001

Applicants filed an Information Disclosure Statement on July 2, 2001. To date, Applicants have not received the Form 1449 filed therewith and marked as being considered by the Examiner. Pursuant to the provisions of MPEP 609, Applicants request that a copy of the Form 1449, initialed as being considered by the Examiner, be returned to the Applicants with the next official communication.

In the most recent Office Action, the Examiner asserted that the USPTO has no record of an IDS being filed on July 2, 2001. Accordingly, Applicants enclose herewith a copy of the IDS previously filed on July 2, 2001, as well as photocopies of Applicants' "Patent Application Transmittal" form (listing the IDS, Form 1449, and copies of 8 cited references) and of Applicants' date-stamped return post card (listing the IDS, Form 1449, and copies of 8 cited references).

Amendments to the Title and Specification

The title has been amended to more accurately reflect the claimed subject matter by substituting "Systems" for "Methods and Apparatus".

Several typographical errors have been corrected in the specification. No new matter has been inserted by way of these corrections.

Amendments to Claims 4, 33, 35, and 38

Claim 4 has been amended by substituting “a junction” for “the junction”, and by incorporating the subject matter of dependent claim 5. Claim 5 has been canceled.

The dependency of claim 33 has been switched from claim 5 to claim 4.

Claim 35 has been amended by substituting “a junction” for “the junction”, and by incorporating the subject matter of dependent claim 36. Claim 36 has been canceled.

The dependency of claim 38 has been switched from claim 36 to claim 35.

No new matter has been introduced.

Objection to Claim 4

Claim 4 was objected to as informal. It is believed that the amendment made herein to claim 4 overcomes this objection. As mentioned above, the identical amendment has also been made to claim 35. No new matter has been inserted by way of these amendments.

Rejection of Claims 4-6 and 33-39 under 35 U.S.C. §103(a) as Unpatentable over Tuttle in view of Schmidt

Claims 4-6 and 33-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tuttle (U.S. 6,058,497) in view of Schmidt et al. (U.S. 6,717,530). Applicants do not admit that Schmidt is prior art and reserve the right to swear behind Schmidt as provided for under 37 C.F.R. §1.131.

As mentioned earlier, claims 5 and 36 have been canceled.

Tuttle discloses a system to test integrated circuits (12, FIG. 1) using a computer (20, FIG. 3).

Schmidt discloses an integrated circuit with a thermal sensing circuit (see Abstract).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Tuttle in view of Schmidt fails to teach or suggest all of the claim limitations present in independent claims 4 and 35, as amended, so a *prima facie* case of obviousness has not been established.

For example, some of the limitations of claims 4 and 35 that neither Tuttle nor Schmidt disclose are “wherein the computer system is to compare the temperature indication with a temperature value determined by the computer program; wherein if the temperature indication substantially matches the temperature value, the computer system is to bin the at least one IC at that temperature value; and wherein if the temperature indication is less than the temperature value, the computer system is to decrement the temperature value and compare the temperature indication with the decremented temperature value”.

The Examiner stated, regarding claims 5 and 36, that Tuttle discloses the above features. However, Applicants could not find any disclosure within Tuttle to support this assertion, and Applicants respectfully request that the Examiner point out the specific column and line numbers supporting this assertion or else withdraw this ground of rejection.

For the above reasons, claims 4 and 35 should be found to be allowable over any combination of Tuttle and Schmidt, and Applicants respectfully request that the rejection of claims 4 and 35 under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Schmidt should be withdrawn.

Claims 6, 33, and 34, which depend from claim 4, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Claims 37-39, which depend from claim 35, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Additional Elements and Limitations

Applicants consider additional elements and limitations of claims 4, 6, 33-35, and 37-39 to further distinguish over the cited references, and Applicants reserve the right to present arguments to this effect at a later date.

Documents Cited But Not Relied Upon For This Office Action

Applicants need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action, because these references are not made part of the rejections in this Office Action. Applicants are expressly not admitting to this assertion and reserve the right to address the assertion should it form part of future rejections.

Conclusion

Applicants respectfully submit that claims 4, 6, 33-35, and 37-39 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date Feb. 7, 2005

By Ann M. McCrackin
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 7 day of February 2005.

Dennis J. Knehl

Name

D. J. Knehl
Signature